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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,556	12/22/2000	Dennis B. Gilbertson	1112.002US1	1680

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EXAMINER

HENDRICKS, KEITH D

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 12/19/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/746,556	GILBERTSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Keith Hendricks	1761	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 21-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,5</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-20, in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Priority***

This application is a Continuation-in-Part of serial number 09/293,661. However, the application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-20 of this application. The '661 application fails to provide support for the use of soy grits with gluten as a food ingredient composition. Thus, the instantly-claimed invention is afforded the priority date of the filing date of the instant application, namely December 22, 2000.

### ***Claim Rejections - 35 USC § 112***

i) The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 6-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of wheat gluten, does not reasonably provide enablement for the use of any other gluten protein composition, from any random source. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

While the specification is enabling for the use of wheat gluten, and the effects of the combination of soy grits and wheat gluten are provided, it does not provide for a functional product with other gluten sources, "effective to make a food product having a structure substantially the same as a corresponding soy-free product made with wheat flour." Applicants have not shown support for the use of another type of gluten (from corn, etc.) other than wheat, and it is unclear whether simply any random type of gluten would be sufficient and acceptable within the claimed invention, and whether it would function to provide the same effects.

ii) The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “a structure substantially the same as”, is indefinite.

- Initially, it is unclear as to what properties of the “structure” of the food product are to be “substantially the same”. It is unclear if this refers to all possible properties of the “structure”, or if only certain of these properties are intended.
- Further, it is unclear as to what degree one skilled in the art would constitute a structure being “substantially the same” as another. This is a relative term, which renders the claim indefinite. The term “substantially” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 2 is indefinite, as it is unclear as to how a composition “further comprising soy flour” may “comprise up to 100% of the soy protein fraction” by soy grits. Soy flour naturally contains soy proteins, and thus these two limitations appear to conflict with one another.

Claim 4 is indefinite, as the phrase “the ratio of weight percent gluten to soy flour is at least about 1:1.5.” It is unclear as to what ratio would be considered higher, “2:1.5”, or “1:2”. In other words, it is unclear as to which component is intended to be increased, such that a ratio would be “at least” as much.

Claims 10 and 13-15 are indefinite, as claim 8, from which they depend, is not directed to a “dry mix”. It is believed that claims 10 and 13-15 should depend from claim 9.

The last two lines of claim 20, “... so that a ratio is about 1:1.5 weight percent gluten to soy grits is produced”, are grammatically improper. It is suggested that the term “is”, first occurrence, be amended to “of”.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-6 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Feucht (DE 3708622).

Feucht disclose a dry mixture for making bread rolls, which comprises potato flour, 16.9% toasted, defatted soya grits, an emulsifier composition, and 5% vital wheat protein. The emulsifier composition comprises wheat flour. It is noted that wheat gluten is also known in the art as ‘vital wheat gluten’, or ‘vital wheat protein’. Thus, the claimed invention is anticipated by the reference.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (US PAT 4,109,018, of record), in view of the combination of GB 1 522 439, and Feucht.

Thompson discloses a “bread product having an increased protein content.” The composition comprises, among other ingredients, wheat flour, “from about 3 to about 9 parts by weight of an added vital wheat gluten, [and] from about 5 to about 12 parts by weight of a protein material selected from the group consisting of lowfat soy flour, nonfat dry milk...”, etc. (col. 2). The “protein ingredient can comprise any source of plant or animal protein normally employed to enrich foodstuffs” (col. 4, lines 34-36): “The protein material should be incorporated into the formulation of the present invention in an amount ranging from about 5 to 12 parts by weight per 100 parts wheat flour” (col. 4, lines 50-53). At column 19, lines 21-23, it is stated that “other dark varieties [of bread loaves] have been made following the principles described using cracked wheat, bran, rolled oats and even a toasted flaked soy bean.”

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Regarding the structure and properties of the finished food product, Thompson states at col. 3, lines 11-17, that "the baked bread product must simulate some type of currently recognized bread variety in appearance and flavor. ... The formulation of the present invention results in a dough and bread which are sufficiently close to standard white bread that no problems in processing or acceptability exist."

GB 1 522 439 discloses "bakery products in the preparation of which debittered soya grits have been used" (pg. 1, col. 2). The product shows "improved baking qualities compared to conventional soya flour." Page 2, col. 1, as well as claims 7 and 9 of the reference, show that "soya grits, soya flour and/or a protein extract, e.g. one obtained from soya beans and preferably in flour form, may be used in the preparation of bakery products according to the invention." "The soya content of the dry ingredients... is conveniently from 5 to 60% by weight. Preferably the soya-content of the dry ingredients will be from 20 to 40% by weight which, in the case of, for example, bread, leads to a protein content of about 16% by weight in the bakery product."

Feucht is taken as cited above.

Thus, it would have been obvious to one of ordinary skill in the art to have provided a dry mix food ingredient for the production of various baked foodstuffs, comprising both soy grits and gluten. The concept of combining soy grits with other bread-making components in a mix for producing baked foodstuffs, in general, was known in the art, for example as taught by the secondary references. Regarding current dependent claims 2-5, 9-12, and 17-19, Thompson provides the components of a known bread dough mixture, which include wheat flour, vital wheat gluten and lowfat soy flour. The gluten amount ranges from about 3 to 9 parts by weight, and the soy flour ranges from about 5 to 12 parts, thus meeting the ratios of instant claim 4. The motivation to combine these components arises from the teachings found in each of the references themselves: (a) GB '439, which utilizes soy grits and/or soy flour, and wheat flour, which naturally contains an amount of gluten, (b) Feucht, which teaches the combination of soy grits, wheat flour and 'vital wheat protein (i.e. gluten), as well as (c) Thompson, which not only utilizes wheat flour, wheat gluten, and soy flour, but also includes "a protein source", which "can comprise any source of plant or animal protein normally employed to enrich foodstuffs." As both secondary references utilized soy grits as an additional protein source, this would have been an obvious component to utilize within the system of Thompson. In fact, Thompson utilized toasted flaked soy bean, from which soy grits are ground and derived.

The production of a 'kit', with containers for the food ingredient components, would have been an obvious matter of design choice for market sale of the obvious combination of components, and would

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not have involved a patentable contribution to the art. Kits and such containers, for example individual packages in boxes, for breads and cakes with flour/dough components, were well-known and utilized in the art, and were a common means for enclosure, transportation and distribution of dry bread mixes. Again, the general idea of adding soy grits to gluten, wheat flour and/or soy flour, for use in various baked foodstuffs, was known and suggested in the prior art, and thus applicants' claims can not be considered patentable.

### ***Double Patenting***

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 53-64 of copending Application No. 09/293,661. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the '661 application are also drawn to a food ingredient comprising gluten and soy grits (as well as soy flour, and other additional components). Note the rejection under 35 U.S.C. 112, first paragraph, in the '661 application, for lack of support in the original disclosure for the use of soy grits.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
KEITH HENDRICKS  
PRIMARY EXAMINER